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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,998	12/26/2001	Joseph Honein	IM 1725 CIP	2457
7590 Kenneth H. Johnson P.O. Box 630708 Houston, TX 77263	03/24/2008		EXAMINER CHIN SHUE, ALVIN C	
			ART UNIT 3634	PAPER NUMBER
			MAIL DATE 03/24/2008	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOSEPH HONEIN

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Appeal No. 2007-0228  
Application 10/035,998  
Technology Center 3600

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Decided: March 24, 2008

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Before WILLIAM F. PATE, III, TERRY J. OWENS, and MURRIEL E. CRAWFORD, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 13 and 16. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a scaffolding plank which includes a plurality of wooden boards held together in compression by pins disposed in bores in the wooden boards (Specification 1, 10).

Claim 1 under appeal reads as follows:

1. A composite scaffolding plank comprising:
  - a plurality of wooden boards each having a fiber bending value of at least 2200 psi, a modulus of elasticity in the range of  $1.6 \times 10^6$  to  $1.8 \times 10^6$ , a lengthwise direction, two opposing sides being flat and extending parallel to said lengthwise direction, each of said sides having a height, said height being the smallest dimension of said wooden boards;
  - said plurality of wooden boards positioned in side to side parallel abutment;
  - at least three bores extending through said plurality of wooden boards in a first direction;

at least three spaced helical pins extending transversely in a second direction opposite to said first direction through and imbedded in said bores in said plurality of wooden boards, said plurality of wooden boards being under compression, normal to said wooden board sides and normal to said lengthwise direction; and said plurality of wooden boards being held together in compression by said helical pins.

The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Anguera,

The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Larsen.

The Examiner rejected claims 1 to 5, 7 to 12 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Larsen in view of Anguera.

The Examiner rejected claims 9 to 11 under 35 U.S.C. § 103(a) as being unpatentable over Larsen, Anguera, and Bouton.

The Examiner rejected claims 6 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Larsen, Anguera, Bouton, and Anglehart.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Anguera	2,567,191	Sept. 11, 1951
Bouton	2,569,450	Oct. 2, 1951

Larsen <sup>1</sup>	84-807	Jan. 6, 1958
Anglehart	JP 01267002	Oct. 24, 1989

Appellant contends that Anguera does not disclose the recited bending value and modulus of elasticity of the wooden boards or that the wooden boards are held together under compression by pins.

Appellant also contends that Larsen does not disclose wooden boards that are held together under compression by pins

## ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in finding that Anguera discloses wooden boards held together under compression by pins.

The second issue is whether the Appellant has shown that the Examiner erred in finding that the specific bending value and the modulus of elasticity of the wooden boards recited in claim 16 are result effective variables and that the optimization of the variables would have been well within the skill of an ordinary artisan.

The third issue is whether Larsen discloses wooden boards held together under compression by pins.

## FINDINGS OF FACT

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<sup>1</sup> A Denmark Foreign Patent.

Anguera discloses a scaffold plank including wooden boards which are compressed by clamp plate 34 against the stop plate 33 and while in the compressed condition pins are driven into the wooden boards (col. 9, ll. 26 to 46; Figures 1 and 16). As the pins are driven into the wooden boards while they are in a compressed state the boards are held together in compression (col. 6, ll 36 to 38).

Larsen discloses that in the prior art planks were laid side by side and held together by a transverse binding iron at each end of the element (Page 4). Larsen does not disclose that the planks are pressed together prior to the insertion of the binding irons.

The ordinary and customary meaning of the word “compress” is to press or squeeze together. Webster’s Online Dictionary.

<http://www.websters-online-dictionary.org/>.

## ANALYSIS

### *New Rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph*

Claims 1 to 13 are rejected under 35 U.S.C. §, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. Independent claims 1 and 7 recite that the bores extend in a first direction and that the pins extend in a second direction opposite to the first direction. However, the pins 50 and bores 40 of Appellant’s invention in fact extend in the same

direction as is depicted in Figure 1. Therefore, the recitation in the claims is misdescriptive.

Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 103 is not made. See *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984). Therefore, in the interest of judicial economy, we will address the rejections under 35 U.S.C. §§ 102(b) and 103(a).

#### *Rejection of claim 16 over Anguera*

We are not persuaded by the argument of Appellants that Anguera does not teach that the therein disclosed boards are held together under compression. Anguera clearly discloses that the boards are held under compression between clamp plate 34 against the stop plate 33 when the pins are inserted.

We are also not persuaded by the Appellant's argument that the subject matter of claim 16 would not have been obvious in view of the teachings of Anguera because Anguera does not disclose the recited bending value and the modulus of elasticity of the wooden boards. The boards disclosed in Anguera have a bending value and a modulus of elasticity. We

agree that Anguera does not disclose the exact value of the bending value and modulus of elasticity. However, the bending value and the modulus of elasticity are result effective variables. The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. *See In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) and *In re Aller*, 220 F.2d 454, 456 (CCPA 1955). As stated in *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996):

This court and its predecessors have long held, however, that even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art, unless the claimed ranges "produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

Additionally, as stated in *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990):

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range [citations omitted].

In the present case, however, the Appellants has not even alleged, much less established, that the claimed bending value and modulus of elasticity produce unexpected results. Therefore, we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of Appellant's invention to select an optimum value for the bending value and the modulus of elasticity which would have been optimum for a desired use.

In view of the foregoing, the Examiner's rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over Anguera is sustained.

*Rejection of claim 16 over Larsen in view of Anguera*

We will sustain the Examiner's rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over Larson in view of Anguera because as we noted above, claim 16 us unpatentable over Anguera alone.

However, since our reasons for sustaining this rejection of claim 16 is materially different from those set forth in the Answer, we designate our action as including a new ground of rejection against claim 16 pursuant to 37 C.F.R. § 41.50(b)(2004).

*Rejection of claim 16 over Larsen*

We agree with the Appellant that Larsen does not disclose that the flat elements are pressed together and as such does not disclose that the flat elements are held together in compression as required by claim 16. Therefore, we will not sustain this rejection.

*Remaining Rejections*

In each of the remaining rejections under 35 U.S.C. § 103, the Examiner relies on Larsen for teaching that the wooden boards are held together in compression by the binding irons. We have found that Larson does not disclose that the wooden boards are pressed together. Therefore, we will not sustain these rejections.

1      Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

Appeal 2007-0228  
Application 10/035,998

AFFIRMED-IN-PART 41.50 (b)

jlB

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